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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,543	12/13/2001	Arlen L. Roesner	10014774 -1	8101

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2835

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 10

Application Number: 10/017,543

Filing Date: December 13, 2001

Appellant(s): ROESNER ET AL.

Louis A. Mok, Reg. No. 22,585
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/27/03.

(1) ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-30 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,197,859	Green et al.	03/2001
6,245,400	Tzeng et al.	06/2001
6,049,458	Lee et al.	04/2000

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 6-9, 22-25, 27-30 are rejected under 35 U.S.C. 102(a). This rejection is set forth in prior Office Action, Paper No. 7.

Claims 5, 10-21 and 26 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 7.

(11) *Response to Argument*

The appellant's argument that the Green reference teaches layers of phase change material on both sides of the carrier and teaches away from having a pliable thermal compound on the other side of the carrier as claimed in the instant application is not convincing since the dry film phase change material disclosed by Green is also the pliable, thermally conductive material specified in the present claims. In response to appellant's argument that the Green reference eliminates silicone grease it must be noted that in fact Green indicates: "In certain applications, heat spreaders may be employed along the thermal path to achieve certain heat dissipating objectives, and interface coatings of the present invention may be employed along the surfaces of heat spreaders as well." (col. 2, lines 33-37) and just above that statement (col. 2, lines 26-31) it indicates that silicone grease is one of such thermal spreaders, therefore, as required by anticipation under 35 USC § 102, "each and every element as set forth in [a] claim [be] found, either expressly or inherently described in a single prior art reference". In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

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combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case the appellant's argument that the protective peelable covering as disclosed by Tzeng et al. is applied over pressure sensitive adhesive, but not over the pliable thermal compound as claimed, is not persuasive because the pressure sensitive adhesive is the pliable thermal compound in the primary reference Green. The Tzeng reference clearly suggests using such peelable protective backing in structures similar to the ones disclosed by Green, and one of ordinary skill in the art would find that it can be done with reasonable expectation of success, therefore combining of these two references is proper.

With respect to claim 12, Appellants contend that the ancillary reference Tzeng is not even mentioned. Claim 12 is dependent on claim 10. Claim 10 inter alia requires "a removable protective covering overlaying the pliable, thermal compound layer". Tzeng has been applied, within the meaning of 35 USC 103, to show that such protective covers are conventional in this art. Lee et al. has been applied to claim 12 to show that specifically protective cap as "a removable protective covering overlaying the pliable, thermal compound layer" is also well known in the art, with the expressed motivation that the cap protects the thermal grease, i.e. the "pliable, thermal compound layer". For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Boris Chervinsky, Primary Patent Examiner
March 20, 2003

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